

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte RICHARD CWIAKALA, WILLIAM J. ROONEY,
PETER B. YOCOM and HARRY M. YUDENFRIEND

AUG 26 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Application No. 09/407,544

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on August 5, 2003. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On September 25, 2002, the examiner entered a Final rejection of the following claims on appeal (Paper No. 8):

- Claims 1-42 under 35 U.S.C. § 103(a) as being unpatentable over Maeurer in view of D'Errico
- Claims 44, 46 and 47 under 35 U.S.C. § 103(a) as being unpatentable over Maeurer as applied to claim 43, and further in view of D'Errico
- Claims 43 and 45 under 35 U.S.C. § 102(b) as anticipated by Maeurer

However, in the Examiner's Answer mailed April 29, 2003 (Paper No. 14), the examiner drops the rejection of claims 46 and 47 under § 103(a) as being unpatentable over Maeurer, but then

rejects claims 46 and 47 under § 102(b) as anticipated by Maeurer. This constitutes a new ground of rejection. According to the Manual of Patent Examining Procedure (MPEP) § 1208.01 (8th ed., rev. 1, Feb. 2003):

37 CFR § 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

Accordingly, it is

ORDERED that the application is returned to the examiner to reopen prosecution to address the new ground of rejection of claims 46 and 47, to notify appellants in writing regarding the new ground of rejection, and for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:



KIMBERLY JORDAN
Program and Resource Administrator
(703) 308-9797

cc: Blanche E. Schiller Esq.
Heslin & Rothenberg PC
5 Columbia Circle
Albany, NY 12203

KJ/clm/meh
RA03-0511